

### **Remarks**

Claims 1-6, 8, 10-13, 19-24, and 27 are being examined on the merits. Claims 28-33 have been withdrawn by the Examiner.

In the Office Action, the Examiner provisionally rejected Claims 1-6, 8, 10-13, 19-24 and 27 on the ground of nonstatutory obviousness-type double patenting (ODP) as being unpatentable over claims in co-pending U.S. Application No. 10/648,009. Because prosecution remains pending in this application and that of co-pending U.S. Application No. 10/648,009, Applicants respectfully request the provisional ODP rejection be held in abeyance. In addition, when two applications are co-pending, the provisional ODP rejection should be removed from the application that first moves to allowance.

In numbered paragraph 6 of the Office Action, the Examiner rejected Claims 1-6, 8, 10-13, 19-24 and 27 as being anticipated by or in the alternative as being obvious over U.S. Patent No. 3,365,315 (Beck). Applicants respectfully point out several distinctions between Beck and the claimed invention. First, Beck in no way makes it clear in any predictable manner what the starting material for making its glass bubbles is. While Beck does teach suitable ingredients for a starting material that may be in glass particles used for practicing the invention, the reference itself at Table 1 only discloses the general ingredients for a starting material. Beck further teaches specifically that “soda-lime-silica glass” is used successfully to form the glass bubbles (Col. 4, ll. 20-21). However, nowhere in Beck does the reference ever teach the exact starting material except in Examples 1-5, which clearly state that the starting material is always a glass cullet, which is a soda-lime-silica glass. Thus, based on the very disclosure of Beck, it is glass cullet (a soda-lime-silica glass) used to form the glass bubbles of Beck. With regard to a final formed composition, Beck never teaches anything about what the final composition actually is when bubbles are formed. Based on the teachings of Table I, one of ordinary skill in the art would not be able to decipher what the exact composition of the formed product would be, particularly when further methods of making are also not clearly or predictably disclosed (i.e.,

variables in melting temperature, heating and re-heating temperatures, addition of one or more inorganic material(s) and/or gases are also disclosed). Beck merely provides in Table I an abundance of ranges and ingredients suitable for a glass former that is used to make the glass bubbles of Beck, but such starting ranges and ingredients cannot be relied on in any predictable manner when the very teachings for the starting composition is vague and unreliable. Consequently, the very nature of Beck's disclosure is unpredictable. This leads Applicants to reiterate another distinction between Beck and Applicants' claimed invention, including the fact that, contrary to the Examiner's suggestion, Beck does not ever teach the composition of the formed glass bubbles. What is clear in Beck is that the final material when formed as glass bubbles will be different than its starting material, but, again, there is no specific teaching anywhere in Beck as to what the final composition actually is. The showing in Beck that the starting material is different from its formed product can be found in the Examples, such as when Beck describes the ingredients for the starting material of Example 1 at Col. 6, lines 26-30, and then recites that when formed, bubbles include different ingredients within internal voids of the formed product (Col. 7, ll. 4-7). Thus, to arrive at a rejection of anticipation or obviousness, the Examiner appears to be comparing two entirely different compositions, a starting material as disclosed in Beck with that of a formed product as disclosed in Applicants claimed invention. Moreover, the Examiner is attempting to hold Applicants to an unpredictable teaching of Beck with regard to Table 1 and lines 39-40 that does not even teach Applicants' claimed invention. Applicants' submit that such a comparison between Applicants' claims and the Beck reference cannot be relied on for a rejection of either obviousness or anticipation because the Examiner has not met the burden of providing a *prima facie* case that the cited document, Beck, either anticipates or is obvious over the claimed invention. Applicants submit that because the Beck document is unpredictable with regard to the very teaching of the composition of formed bubbles, the reference itself cannot be relied on. Applicants further point out that while there is some clarity in Examples 1-5 with regard to a teaching of starting materials used by Beck, Examples 1-5 only teach with any clarity that of the glass former composition, that is what the

ingredients of the starting glass material is. In Examples 1-5, Beck teaches that the starting material is always a glass cullet containing 1.2 wt.% aluminium oxide and 14.2 wt.% sodium oxide (Examples 1-3) or a glass cullet containing 1.8 wt.% aluminium oxide+iron oxide and 14.1 wt.% sodium oxide (Example 4) or a glass cullet containing 1.2 wt.% aluminium oxide and 13.5 wt.% sodium oxide (Example 5). If one relies on the teachings in Examples 1-5 as to what the starting material is, it is clear that Beck does not teach or suggest a starting material that may be used to anticipate or make obvious Applicants' claimed microspheres when formed. As such, Applicants respectfully request the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) be removed.

With respect to Amendments to the Specification as provided in an Amendment document submitted by Applicants on February 1, 2008, Applicants respectfully point out that the amendment to the specification that began on page 2 of the submitted paper should be directed to paragraph [0100] of the as-filed specification and that the amendment that began on page 3 of the paper should be directed to paragraph [0101] of the as-filed specification.

### **Conclusion**

In light of the remarks presented with this Amendment, Applicants respectfully submit that the pending claims provided in the Listing of Claims beginning on page 2 of this paper are in condition for allowance. Accordingly, favorable consideration for and allowance of the claims are respectfully requested.

This response is being filed with a Petition for Extension of Time for two months and the appropriate fees. No additional fees are believed due with this paper. To the extent that further fees are required, the Commissioner is hereby authorized to charge payment of said further fees to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843-1099.

In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant such a petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

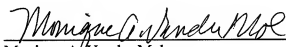
Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214-999-4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application and/or place the application in condition for allowance.

This is intended to be a complete response to the Office Action mailed on the date of March 20, 2008.

**Please direct all correspondence to the practitioner listed below at Customer No. 60148.**

Respectfully submitted,

Gardere Wynne Sewell LLP

A handwritten signature in black ink, reading "Monique A. Vander Molen", is written over a horizontal line.

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